

REMARKS

Claims 1, 3-10 and 12-17 are currently pending in the application. By this amendment, independent claims 1 and 10 have been amended to more clearly define the instant invention. No new matter has been entered.

Applicant notes that, the current pending application is assigned to Flatwire, Inc. and is recorded as Reel/Frame No. 015198/0709. Further, Applicant wishes to bring to the Examiner attention that Flatwire, Inc. has changed its name from "Flatwire, Inc." to - - Wireless Directory Network, Inc.- -. Applicant presents an executed Articles of Amendment form No. MBCA-9 under the Domestic Business Corporation Department from the State of Maine, evidencing documentation of the above-noted name change. See Attachment A. A copy of this Articles of Amendment is being concurrently recorded with the Assignment Department of the United States Patent & Trademark Office.

Accordingly, reconsideration is requested in view of the amendments and the accompanying remarks.

Amendment Fully Supported by the Original Disclosure

The above amendments do not add new matter to the application and are fully supported by the specification. For example, support for amending independent claims 1 and 10 to recite, "and charging a fee to said requester for sending the notification message," is provided at paragraphs [0016], [0019], [0023], [0026], [0033], [0036] and [0037] of the specification.

35 U.S.C. §103 Rejection

Claims 1, 3-10 and 12-17 are rejected under 35 U.S.C. § 103(a) as being

unpatentable over Dowdy (Publication No: US 2003/0206616) (hereafter "DOWDY") in view of Meadows et al. (hereafter "MEADOWS"). This rejection is respectfully traversed. Applicant brings forth the following remarks concerning the Examiner's assertions in the office action dated September 5, 2006:

(Remark No. 1) Applicant submits that no proper combination of DOWDY and MEADOWS teach or suggest the features of Applicant's claimed invention, if anything, Applicant submits the Examiner is using impermissible hindsight based on Applicant's disclosure;

(Remark No. 2) Applicant further submits a review of the § 103 rejection requirements for an Examiner to first establish a prima facie case of obviousness according to MPEP 2143, 2143.01(I) and (IV);

(Remark No. 3) Applicant's also submits that the rationale for arguing the Examiner's assertions of impermissible hindsight for the instant Office Action is in accordance with MPEP 2145(X);

(Remark No. 4) Applicant provides concurrently a copy of a signed License Agreement that Applicant believes shows proof of commercial success, which is in accordance with the standards of patentability as applied in obviousness rejections under MPEP 2141(I) and MPEP 716-716.06), and is also in accordance with the standard of patentability enunciated by the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966);

(Remark No. 5) Applicant submits that, the requisite motivation derived by the Examiner must stem from some teaching, suggestion or inference in the prior art as a whole or from knowledge generally available to one of ordinary skill in the art and not from Applicant's disclosure.

Remarks No. 1-3

The Examiner asserts that DOWDY shows all the features of the claimed invention except for sending the notification message to the subscriber by text messaging, and it would have been obvious to one of ordinary skill in the art to implement the technique of MEADOWS within the system of DOWDY in order to leave text messages for monitored individuals when voice communication is not necessary. Applicant respectfully disagrees with the Examiner's assertions.

Applicant's independent claim 1, as currently amended, recites, *inter alia*:

"A method for sending a notification message to a telecommunication subscriber without revealing unpublished contact information, said method comprising:

providing a requestor of unpublished contact information of a telecommunication subscriber an opportunity to indirectly send said subscriber a notification message;

collecting information from said requestor regarding content of said notification message; and

sending said notification message to said subscriber by text messaging and charging a fee to said requester for sending the notification message."

Applicant's independent claim 10, as currently amended, recites, *inter alia*:

"A system for sending a notification message to a telecommunication subscriber without revealing unpublished contact information, said system comprising:

means for a requestor of unpublished contact information to request the telecommunication subscriber contact information;

means for providing the requestor of unpublished contact information of a telecommunication subscriber an opportunity to indirectly send said subscriber a notification message; ;

means for collecting information from said requestor regarding content of said notification message; and

means for sending said notification message to said subscriber by text messaging and charging a fee to said requester for sending the notification message."

Applicant submits that no proper combination of DOWDY and MEADOWS teach or suggest the above-noted features, if anything, Applicant submits the Examiner is using impermissible hindsight based on Applicant's disclosure.

DOWDY shows a messaging system for a restricted party having an intelligent services network and a messaging device. The messaging device is associated with the intelligent services network, wherein a calling party can receive contact information and leave a message for the restricted party. In particular, the messaging system can leave a message to unlisted parties where a phone number is restricted from calling party access, by leaving a voice message, or alternatively by an e-mail address, internet protocol (IP) address, post office box address, uniform resource locator (URL), pager number, or the like (see claim 1 and paragraphs [28] to [0031], but nothing in DOWDY teaches or suggests means for *sending said notification message to said subscriber by text messaging and charging a fee to said requester for sending the notification message*, as at least recited in independent claims 1 and 10, as currently amended.

MEADOWS shows a system for monitoring the geographical location of a subscriber's mobile cellular telephone, and for providing the location information to an authorized user through the Internet. See Abstract of MEADOWS. Further, the monitoring system provides a user to access the system through the Internet to monitor the geographic location of a person being monitored and leave a text message for the person so as not to interrupt the person's activities with a telephone call (see Col. 6, lines 55-61), but nothing in MEADOWS teaches or suggests means for *sending said notification message to said subscriber by text messaging and charging a fee to said requester for sending the notification message*, as at least recited in independent claims 1 and 10, as

currently amended.

Applicant submits that, contrary to the Examiner's assertions, the fact that the claimed invention maybe within the capabilities of one of ordinary skill in the art (which Applicant submits it is not), it is not sufficient by itself to establish a prima facie obviousness argument. See MPEP 2143.01(IV). Applicant's claimed invention discloses, in part, a text message that is sent requesting unpublished wireless contact information, wherein the requester is charged a fee for sending this message. The aspect of charging a fee represents a solution to a problem because telemarketers are not willing to pay for phone numbers. By sending an email message (as taught by DOWDY) there is no charge to the sender and no barrier to telemarketer requests, which is simply not a workable solution. Moreover, there is no teaching or suggestion in the Examiner's discussion that addresses an objective reason to combine the teachings of the references from one 'well within the ordinary skill of the art at the time the claimed invention was made' (see MPEP 2143.01(IV), that address *sending said notification message to said subscriber by text messaging and charging a fee to said requester for sending the notification message*, as at least recited in the independent claims, as currently amended. Clearly, the Examiner must be able to understand and appreciate the importance of the Applicant's claimed invention, of creating a solution to a problem of restricting telemarketers access to telecommunication subscribers having unlisted or restricted numbers, e.g., by charging a fee for sending notification.

Therefore, for the reasons stated above, Applicant respectfully submits it would not have been obvious to modify the teachings of DOWDY and MEADOWS to that of the features of the instant invention.

A § 103 rejection requires the Examiner to first establish a *prima facie* case of obviousness: 'To establish a *prima facie* case of obviousness, three basic criteria must be met.' See MPEP 2143.

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Second*, there must be a reasonable expectation of success. *Finally*, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." See MPEP 2143.

Further, when applying a § 103 rejection 2143.01 (I) of the MPEP states:

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)." See MPEP 2143.01 (I).

Moreover, as discussed above, MPEP 2143.01(IV) states a § 103 rejection requires the Examiner to first establish a *prima facie* case of obviousness: 'The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness'.

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach

that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.). See MPEP 2143.01(IV).

Further, as discussed above, DOWDY teaches a method for sending a notification message to an unpublished telecommunication subscriber without revealing the unpublished contact information, providing a requestor (or caller) an opportunity to indirectly send the subscriber a notification message, collecting information from the requestor regarding content of the notification message (i.e., leaving a message to the unlisted subscriber, and sending the notification message to the subscriber. See paragraphs [0025] to [0026] of DOWDY. However, there is no teaching or suggestion in DOWDY that a user is charged a fee for sending an email, as in the context discussed above.

Further, Applicant submits the rationale for concluding the Examiner's assertions are impermissible hindsight based based on Applicant's disclosure (e.g., it would have been obvious to one of ordinary skill in the art to implement the technique of MEADOWS within the system of DOWDY), is in accordance with MPEP 2145 (X), which recites, in part:

Applicants may argue that the examiner's conclusion of obviousness is based on improper hindsight reasoning. However, "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin* 443 F.2d 1392,

1395, 170 USPQ 209, 212 (CCPA 1971). Applicants may also argue that the combination of two or more references is "hindsight" because "express" motivation to combine the references is lacking.

Furthermore, as discussed above, Applicant submits that when a text message is sent requesting unpublished wireless contact information, the requester is charged a fee for sending this message. This represents a solution to a problem because telemarketers are not willing to pay for phone numbers. By sending an email message (as taught by DOWDY) there is no charge to the sender and no barrier to telemarketer requests, this is simply not a workable solution.

Therefore, if not for impermissible hindsight, and contrary to the Examiner's assertions, Applicant submits it would not have been obvious to modify DOWDY in such a way to render the instant invention unpatentable, as in accordance with the discussions noted-above.

Thus, it will be recognized that Applicant's invention as claimed relates to a method in which a telecommunications subscriber is far more likely to receive a notification message from an interested party of the subscriber rather than from an interested party or a telemarketer message. This is a particularly important distinction since the telecommunications subscriber would not be protected from receiving unwanted, annoying and expense ridden telemarketing messages.

Remark No. 4

Applicant submits a copy of a binding Memorandum of Understanding to provide evidence of commercial success, as outlined in MPEP 2141(I) and further outlined in MPEP 716-716.06. See Attachment B. Further, the standard of patentability to be applied

in obviousness rejections recites that 'Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case.' The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated, in part:

"Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence. The weight to be accorded to the evidence depends on the individual factual circumstances of each case. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987). The ultimate determination on patentability is made on the entire record. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). >However, evidence developed after the patent grant in response to challenge to the patent validity's should not be excluded from consideration since "understanding the full range of the invention is not always achieved at the time of filing the patent application." *Knoll Pharms. Co., Inc. v. Teva Pharms. USA Inc.*, 367 F.3d 1381, 1385, 70 USPQ2d 1957, 1960 (Fed. Cir. 2004). (reversing the lower court's grant of summary judgment of invalidity for failure to consider 'unexpected results' evidence obtained from post-filing that could be relevant to the patent validity inquiry).".

Applicant submits, the binding Memorandum of Understanding dated January 24, 2007 by and between Wireless Directory Network, e.g., formally named Flatwire, Inc., who have the assigned rights of the instant application 10/820,614, and a corporation with offices located at 3007 Main Street, Carrabassett, ME 04947 (Licensor), and Wireless Directory Europe, S. L., a corporation with offices located at Pasaje de la Fundacion 15, L-10, 28028, Madrid, Spain (Licensee). As discussed above, Applicant's assignee has changed its name from "Flatwire, Inc." to - -Wireless Directory Network, Inc.- -. Please see Attachment A.

Applicant wishes to bring to the Examiner's attention that Applicant's Assignee

Wireless Directory Network, Inc., has a corporate name that appears to be similar to Wireless Directory Europe, S. L. However, Wireless Directory Network, Inc. is not an Affiliate of Wireless Directory Europe, S. L. For the purposes of the preceding sentence, "Affiliate" means an entity that directly or indirectly through one or more intermediaries controls, or is controlled by, or is under common control with, another entity and "control" means the ownership of more than fifty percent (50.0%) of outstanding capital stock or other equity interest. In particular, all of the voting stock of Wireless Directory Network, Inc. is owned by Jeffery Strunk and Tracy Butler and the non-voting stock is owned by over 50 individuals and related trusts. Moreover, Wireless Directory Network Europe, S.L. is a Spanish company with offices located at Pasaje de la Fundacion 15, L-10, 28028, Madrid, Spain. All of the stock of Wireless Directory Network Europe, S.L. is owned by Katrin Seeger, a natural person residing in Madrid, Spain. The company was formed in 2006 for the purposes of establishing a wireless directory network in Spain and other EU countries under license from Wireless Directory Network, Inc.

In accordance with guidelines set forth by MPEP 716.01(b), 716.03 and the U.S. Supreme Court as noted-above, the License Agreement represents factual evidence of secondary considerations relevant to the subject matter as claimed. For example, Appendix A (Patent Rights and Related Technology) of the above-mentioned License Agreement discloses the proprietary technologies as Patent Cooperation Treaty Patent Application No. US04/010743 (a counterpart application to the instant US Patent Application No. 10/820,614), which substantially recites the originally filed claim 1 of the instant application:

"ComNote® -- A system and method in which unpublished subscribers of telecommunications services are able to receive a notification that an individual

is trying to contact them, without revealing unpublished contact information. A requestor of a telecommunication subscriber's unpublished contact information is given an opportunity to indirectly send the subscriber a notification message. This is accomplished by collecting information from the requestor regarding the desired content of the notification message and then sending the notification message to the subscriber. The unpublished subscriber receiving such a notification message has the choice of contacting the requestor or ignoring the notification message."

Further, for the Examiner's convenience, Applicant submits the originally filed claim 1 of the instant application, which recites:

"A method for sending a notification message to a telecommunication subscriber without revealing unpublished contact information, said method comprising:

providing a requestor of unpublished contact information of a telecommunication subscriber an opportunity to indirectly send said subscriber a notification message;

collecting information from said requestor regarding content of said notification message; and

sending said notification message to said subscriber by text messaging and charging a fee to said requester for sending the notification message."

Applicant submits that, the proprietary technologies (Patent Cooperation Treaty Patent Application No. US04/010743, or a counterpart application to US Patent Application No. 10/820,614)) discloses substantially the same subject matter. Thus, Applicant submits that a "nexus" and/or a factually and legally sufficient connection between the objective evidence of non-obviousness and the claimed invention is made, such that the evidence is of probative value for the determination of non-obviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), *cert. denied*, 488 U.S. 956 (1988).

Moreover, Applicant submits that, the burden of proof for establishing a nexus between the claimed invention and evidence of commercial success has been established

by the showing that the language presented in the License Agreement is substantially the same as the originally file claim 1 of the US counterpart application, as required under MPEP 716.03(a) and 716.03(b). In particular, for the Examiner's convenience, Applicant submits 716.03(a), which recites, in part:

"MPEP 716.03(a) Commercial Success Commensurate in Scope With Claimed Invention

I. Evidence Of Commercial Success Must Be Commensurate In Scope With The Claims:

Objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of thermoplastic foam "cups" used in vending machines was not commensurate in scope with claims directed to thermoplastic foam "containers" broadly). In order to be commensurate [>]in[<] scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 229, 17 USPQ2d 1257, 1260 (D.D.C. 1990), *aff'd*, 959 F.2d 226, 228, 22 USPQ2d 1153, 1156 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue.)."

Applicant further notes that, evidence of commercial success or license is directly derived from the invention claimed, as noted above, that the language from the License Agreement is substantially the same as the originally filed claim 1 of the instant invention. See *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) and MPEP 716.03(b) (I and II).

Applicant submits, the presentation of the License Agreement is in accordance with guidelines set forth by MPEP and the U.S. Supreme Court as noted-above, and represent objective evidence or secondary considerations, e.g., commercial success, long-felt need, failure of others to invent, which are relevant to the issue of obviousness and must be considered and evaluated by the Examiner. See also *Stratoflex, Inc. v. Aeroquip Corp.*,

713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987). Further, Applicant submits that the Examiner's ultimate determination on patentability needs to be made on the entire record and not just on a portion of the record. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Remark No. 5

Further, even assuming, *arguendo*, that DOWDY in view of MEADOWS can be combined, which Applicant submits it does not in accordance with the above-mentioned comments, the Examiner has not shown any rationale as to *why* one ordinarily skilled in the art would be motivated to modify the DOWDY with the text messaging of MEADOWS, particularly when the text messaging is charge a fee, which is at least recited in Applicant's independent claims, as currently amended.

Applicant notes that, under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have found it obvious to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. *See Ex parte Clapp*, 227 USPQ 972 (B.P.A.I. 1985) To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Applicant's disclosure. *See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Notwithstanding the Examiner's statement in the rejection that "it would have been obvious to one of ordinary skill in the art to implement the technique of MEADOWS within the system of DOWDY in order to leave text messages for monitored individuals when voice communication is not necessary", to obtain the same

advantages," Applicant contends that this is not a reason *why* one of ordinary skill in the art would have been led to modify any of the devices of the DOWDY device, in view of charging a fee for text messaging, which is at least recited in Applicant's claimed invention, as currently amended. Moreover, it is respectfully submitted that the courts have long held that it is impermissible to use Applicant's claimed invention as an instruction manual or "template" to piece together teachings of the prior art so that the claimed invention is purportedly rendered obvious. See *In re Fritch*, 972 R.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

As the art of record fails to provide the requisite motivation or rationale for combining the DOWDY and MEADOWS in the manner asserted by the Examiner, especially in view of a fee being charged for text messaging, as at least recited in Applicant's independent claims, as currently amended. Applicant submits that the asserted combination is improper and should be withdrawn.

For these reasons, Applicant respectfully submits that independent claims 1 and 10 are allowable over DOWDY and MEADOWS or any proper combination thereof, or of the prior art of record. Claims 2-9 and 12-17 are also allowable over DOWDY and MEADOWS because of their dependency from an allowable base. Withdrawal of the rejection of claims 1, 3-10 and 12-17 is respectfully requested.

CONCLUSION

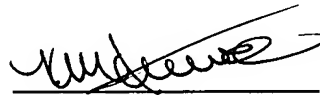
In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious Applicant's invention, as recited in each of claims 1, 3-10 and 12-17. The applied references of record have been discussed and distinguished, while significant claimed features of the present

invention have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully submitted,
Jeffrey L. STRUNK

A handwritten signature in black ink, appearing to read 'Kevin M. Farrell', is written over a horizontal line.

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